PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No.:	09/825,969
Filed:	April 4, 2001
Applicant(s):	Thomas D. Doerr
Title:	Physician Decision Support System With Improved Diagnostic Code Capture
Art Unit:	3626
Examiner:	Rachel L. Porter
Docket No.:	951130.90029

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

The issue at hand pertains to the proper legal test for establishing a *prima facie* case of obviousness and the considerations that obviate the establishment of a *prima facie* case of obviousness. Applicant has established, and the Examiner has acknowledged, that the primary reference cited by the Examiner to reject the present application does not teach each and every element of the claims. Hence, the Examiner cited a secondary reference. However, Applicant has shown that the proffered combination is improper because the primary reference expressly teaches away from the modification proposed by the Examiner using the secondary reference.

Therefore, Applicant asserts that "[i]t is improper to combine references where the references teach away from their combination." MPEP § 2145 *citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). However, the Examiner has rejected this long-standing principle of examination procedures and, instead, asserted that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested to those of ordinary skill in the art." Office Action of January 24, 2007, *citing In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant does not disagree with this statement by the Examiner but, nevertheless, asserts that the fact that the primary reference teaches directly away from the proposed modification necessarily obviates the establishment of a *prima facie* case of obviousness, regardless of suggestion for the modification in the secondary reference.

The Examiner has proffered a rejection based on a combination of Evans (U.S. Patent No. 5,924,074) in view of Lewis et la. (U.S. Application No. 2003/0200119 A1) and various other references. That is, the Examiner acknowledged that Evans does not teach "restrict[ing] access to additional support features related to a treatment of a medical diagnosis represented by the specific diagnosis code until a diagnosis code is selected," as claimed. Office Action of October 24, 2006, pg. 4. Applicant has shown that Evans not only fails to teach that which is expressly claimed, but that Evans actually teaches directly away from that which is claimed. Response of December 26, 2006, pgs. 6-7. That is, Applicant has shown that Evans explicitly teaches that additional support features related to a treatment of a medical diagnosis represented by the specific diagnosis code are displayed ***prior to selection*** of a diagnosis code. *See* col. 7, ll. 52-61. Nevertheless, the Examiner attempted to modify Evans contrary to this express teaching using Lewis et al. Hence, Applicant has asserted that the rejection is improper and must be withdrawn.

Specifically, Applicant has asserted that when determining obviousness "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02 *citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). To this end, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As addressed above, the Examiner has rejected this long-standing principle of examination procedures and, instead, asserted that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into

the structure of the primary reference; nor is it that the claimed invention must be expressly suggested to those of ordinary skill in the art." Office Action of January 24, 2007, *citing In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant does not disagree with this statement. However, it does not supersede the fact that a reference which teaches away from the claimed invention cannot be used to assert a rejection against the claimed invention and that it is improper to attempt to modify a reference in a manner inconsistent with an express principle of operation of the prior art invention. *See* MPEP §§ 2141.02 and 2143. Simply, the Examiner has ignored that "[i]t is improper to combine references where the references teach away from their combination." MPEP § 2145 *citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Therefore, Applicant asserts that the combination is improper and the Examiner has failed to establish a *prima facie* case of obviousness. As such, no basis of rejection remains with respect to claim 1. Accordingly, claims 2-9 and 12-22 are in condition for allowance at least pursuant to the chain of dependency. That is, as addressed in detail in the Response of July 13, 2006, Applicant respectfully disagrees with the Examiner with respect to the art as applied to claims 2-9 and 12-22. However, in light of these claims depending from what is believed to be an allowable claim, Applicant does not believe additional remarks are necessary and, therefore, requests allowance of claims 2-9 and 12-22 at least pursuant to the chain of dependency. Accordingly, Applicant requests that the Review Panel find that the present application should be allowed and prosecution on the merits closed.

Respectfully submitted,

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By: _____ 2/23/07

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